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16

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,603	09/22/2003	John Steven Cianflone		6365

7590

,03/11/2005

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EXAMINER

ARYANPOUR, MITRA

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/665,603	CIANFLONE, JOHN STEVEN	
	Examiner	Art Unit	
	Mitra Aryanpour	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claims 3, 11-13, 19, 22 are objected to because of the following informalities: in claim 3, line 9, "cueing" should be changed --cuing--. Appropriate correction is required for the above objection.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: On pages 2 and 3 of the Preliminary Amendment to the Specification "and/or translucent inner core"; "and/or translucent outer covering"; and on page 5 line 9 of the Amendment to the Abstract, "... with a sufficiently transparent spherical outer covering ... inner core may also provide...". The Specification and claims as filed provide no support for the aforementioned.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 14-19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation in claims 14, 16 and 18, "inner core has an actual diameter of 27 mm"

Art Unit: 3711

and “inner core has an actual diameter of 25 mm” in claims 15, 17 and 19 has no support in the specification as filed. The Specification as filed shows that “the optimum inner core should appear 26mm in diameter, the tangible inner core in reality would be designed smaller, about 18 or 19 mm in diameter ... the hypothetical inner core diameter appearance of 26 mm which expectedly has a radius of 13 mm ...”. The aforementioned is not the “actual” diameter, but rather it should appear as if it would be 26mm. In any event there is no support in the Specification for the claimed subject matter.

Additionally, in claims 3, 7, 11-13, 19, 22 and 23 the limitation “an opaque and translucent inner core” and “a transparent and translucent outer covering” raise new issues in the application as filed. The specification and claim as filed only provide support for an opaque inner core and a transparent outer covering .

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

6. Claims 3, 7, 11-13, 19, 22 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 3 and 7, the limitation “an opaque and translucent round inner core” renders the claim vague and indefinite because to be “opaque” means impenetrable by light, which is neither translucent nor transparent. Therefore, it is unclear how the inner core can be both opaque and translucent at the same time, especially since no support has been provided in the specification as filed.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4, 7, 8 and 20-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Chavarria et al (4,116,439).

Regarding claim 1, Chavarria et al shows a billiard ball having a generally spherical outer surface, comprising: (a) an opaque round inner core (the broadest reasonable interpretation of round would include the cylindrical weighted object 71; see figure 3) that is visible through the spherical outer surface;, and (b) a transparent outer covering (by way of example see figure 10), surrounding and encasing said inner core (weighted object), wherein said outer covering displays said inner core and provides an outer surface circumference. It should be noted: the preamble, a billiard training ball, does not limit the structure of the claimed device because the portion of the claim following the preamble is a self-contained description of the structure and does not depend on the preamble for completeness. Additionally, it should be noted: a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, the inner core can serve as a target at which to

Art Unit: 3711 .

aim a cue stick when addressing said billiard-training ball to practice cueing technique when striking the billiard ball.

Regarding claim 2, Chavarria et al shows a billiard ball having a spherical outer surface, comprising: (a) a round (the broadest reasonable interpretation of round would include the cylindrical weighted object 71; see figure 3) translucent inner core (in as much as applicant has shown and described translucent, Chavarria et al also shows a translucent inner core; see column 7, lines 55-57), that is visible through the outer surface, and (b) a translucent outer covering (in as much as applicant has shown and described translucent, Chavarria et al also shows a translucent outer surface; by way of example see figure 10), surrounding and encasing said inner core, wherein said outer covering displays said inner core and provides an outer surface circumference. It should be noted: the preamble, a billiard training ball, does not limit the structure of the claimed device because the portion of the claim following the preamble is a self-contained description of the structure and does not depend on the preamble for completeness. Additionally, it should be noted: a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, the inner core can serve as a target at which to aim a cue stick when addressing said billiard-training ball to practice cueing technique when striking the billiard ball.

Regarding claim 3, note the rejection of claim 1.

Art Unit: 3711

Regarding claim 4, Chavarria et al shows inherently shows the inner core to appear larger to the human eye than it actually is since the outer shell acts as a magnifying glass (see column 8, lines 43-45).

Regarding claim 7. During normal use and operation of the Chavarria et al device, the method steps set forth by applicant in the claim is inherently provided. Such steps including but not limited to the following: providing a substantially opaque inner core of a predetermined size and a sufficiently transparent outer covering of a predetermined size, comprising the steps of: aligning a cue stick with the training ball; and striking the training ball with the cue stick directed toward the inner core in order to impart spin or no spin while limiting deflection to the training ball.

Regarding claim 8, Chavarria et al shows inherently shows the inner core to appear larger to the human eye than it actually is since the outer shell acts as a magnifying glass (see column 8, lines 43-45).

Regarding claims 20-23, Chavarria et al further shows the inner core has a greater density than said outer covering (see column 5, lines 14-28).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5, 6, 9-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chavarria et al (4,116,439).

Art Unit: 3711

Regarding claim 5, Chavarria et al does not disclose expressly the specific size of the inner core, but teaches that it can be made any size or shape. Such is readily apparent from the figures. Therefore, it would have been within the scope of Chavarria et al's invention to make the inner core in the claimed diameter.

Regarding claim 6, Chavarria et al does not disclose expressly the specific size of the inner core, but teaches that the attaining the precise weight and feel of a regular billiard ball is desired. Therefore, it would have been obvious to make the ball of Chavarria et al the same weight as the cue ball so that it can be used as a target or aiming ball.

Regarding claim 9, Chavarria et al does not disclose expressly the specific size of the inner core, but teaches that it can be made any size or shape. Such is readily apparent from the figures. Therefore, it would have been within the scope of Chavarria et al's invention to make the inner core in the claimed diameter.

Regarding claim 10, Chavarria et al does not disclose expressly the specific size of the inner core, but teaches that the attaining the precise weight and feel of a regular billiard ball is desired.

Regarding claim 11, Chavarria et al shows inherently shows the inner core to appear larger to the human eye than it actually is since the outer shell acts as a magnifying glass (see column 8, lines 43-45).

Regarding claim 12, Chavarria et al does not disclose expressly the specific size of the inner core, but teaches that it can be made any size or shape. Such is readily apparent from the figures. Therefore, it would have been within the scope of Chavarria et al's invention to make the inner core in the claimed diameter.

Regarding claim 13, Chavarria et al does not disclose expressly the specific size of the inner core, but teaches that the attaining the precise weight and feel of a regular billiard ball is desired.

Regarding claims 14-19, Chavarria et al does not disclose expressly the specific size of the inner core, but teaches that it can be made any size or shape. Such is readily apparently from the figures. Therefore, it would have been within the scope of Chavarria et al's invention to make the inner core in the claimed diameter.

Double Patenting

11. Applicant is advised that should claim 16 be found allowable, claim 18 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Response to Arguments

12. Applicant's arguments filed 04 January 2005 have been fully considered but they are not persuasive. It should be noted that claim 18 is a duplicate of claim 16 and it should be either amended to cancelled. With regards to the limitation "round" inner core, the American Dictionary defines "round" as **a.** being such that every part of the surface or the circumference is equidistant from the center: *a round ball*. **b.** moving in or forming a circle. **c.** shaped like a cylinder; cylindrical. **d.** rather rounded in shape. With regards to the newly added claims 20-23, Chavarria et al also teaches that the insert should be metallic in order to compensate for the lightweight of the outer surface. As indicated above and in the previous Office Action the

Art Unit: 3711

Preliminary Amendment filed 28 January 2004 raises "new matter". The Specification as filed does not provide support for the added limitations.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mitra Aryanpour whose telephone number is 571-272-4405. The examiner can normally be reached on Monday - Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MA
03 March 2005


MITRA ARYANPOUR
PRIMARY EXAMINER